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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			EXAMINER MILLER, ALAN S	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 10/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/824,808	Applicant(s) ERNEST ET AL.	
	Examiner ALAN MILLER	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/15/2004, 9/2/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed 4/15/2004. A preliminary amendment was filed on 3/14/2008 cancelling claims 1-13 and 15-39 and amending claim 14. Claim 14 is pending and has been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim **14** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14 recites the limitation “performing by a logical device an analysis of said job results against said client-driven performance criteria and said self-reports”. However, turning to the specification for clarification, paragraph 0050 recites “the rating logic obtains real-time data from grid resources in self-reported job statistics...”, and paragraph 0051 recites “The GRRL automatically compares job processing data for each job and each resource against related SLA criterion...”. Further, paragraph 0062 recites “The job results are compared against SLA, including consideration of resource self-reported statistics, as previously described...”. This is different than what has been claimed, since the claimed invention compares job results to both

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SLA and self-reports, while the specification compares both job results and self-reports to the SLA. Correction is requested.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim **14** is rejected under 35 U.S.C. 101 because 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, in claim 14, applicant's method steps, receiving, performing, and producing, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. There is only a nominal recitation of technology in the claims. Thus, claim 14 is non-statutory since it recites only a nominal use of technology and may be preformed within the human mind.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin et al. (U.S. Patent Publication 2002/0107723, hereinafter Benjamin) in view of Main et al. (U.S. Patent 5,893,905, hereinafter Main) in further view of Shoquist et al. (U.S. Patent 5,361,199, hereinafter Shoquist).

8. In respect to claim **14**, Benjamin discloses accessing one or more client-driven performance criteria definitions (§0034, wherein Benjamin discloses that the performance of a supplier is quantified in a performance vector, P_{des} , and that the desired performance is specified when looking for a supplier (i.e. client-driven performance criteria)).

Benjamin further discloses receiving one or more job results from a grid resource (§0034, actual performance supplied by buyer in post-job questionnaire (i.e. job results)),

performing by a logical device an analysis of said job results (e.g. actual performance) against said client-driven performance criteria (e.g. desired performance specified) (see at least §0052-§0070 wherein Benjamin discloses updating the supplier rating matrix and using the supplier matrix to evaluate a supplier; §0035-§0047, wherein Benjamin discloses equations for updating a supplier rating matrix),

said analysis comprising performing one or more analyses pertaining to job types, (see at least ¶0038 and ¶0039 wherein Benjamin discloses Actual Performance and Attributes of job i; and ¶0071 - ¶0075 wherein Benjamin discloses using the disclosed method with multiple jobs, each job with different tolerances (i.e. job types)),

said analysis further comprising determining one or more sub-ratings selected from the group of percentage of jobs completed, percentage of jobs completed within specified time constraints, an interactiveness rating, a cost compliance rating, and a results accuracy rating, (see at least ¶0050, wherein Benjamin discloses each group of columns corresponds to a job attribute, wherein a job attribute is a measurable characteristic of the jobs such as the level of precision (i.e. results accuracy rating)),

said analysis further comprising determining a composite rating using a weighted combination of a plurality of sub-ratings(see at least ¶0065 - ¶0070, wherein Benjamin discloses an overall rating, R, is a weighted average of the performance ratings).

Benjamin further discloses producing a grid resource rating table having sub-ratings, (see at least Tables 1 – 7; see also at least ¶0050, wherein Benjamin discloses each group of columns corresponds to a job attribute, wherein a job attribute is a measurable characteristic of the jobs).

In respect to the recited limitation, having an indication of the age of the information upon which the table is based, having an indicator of the number of jobs upon which the ranking for each resource vendor is based and having a composite rating, this is merely non functional descriptive material, e.g. labels on a table, and it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*,

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70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Benjamin further discloses including producing a human-readable report, producing a computer-readable report (see at least ¶0007, wherein Benjamin discloses the invention can be provided on a webpage and/or on a personal computer (i.e. human readable and computer readable report)).

Benjamin discloses having both a first and second supplier matrix (see at least ¶0018 and Claim 4), each matrix having a weighted analysis of sub-ratings (see at least ¶0065 - ¶0070, wherein Benjamin discloses an overall rating, R, is a weighted average of the performance ratings).

Benjamin further discloses generating and accessing a rating value for each supplier (see at least ¶0018, ¶0065 - ¶0070; see also at least Claim 18),

a job request (see at least ¶0031, wherein Benjamin discloses that the received data relates to a service that is desired (i.e. job request); ¶0034, wherein Benjamin discloses desired performance; Claim 18, wherein Benjamin discloses generating a rating value for each supplier using the modified supplier-rating matrices and the job attributes of the proposed job (i.e. job request)),

a set of supplier characteristics (i.e. grid resource characteristics) (see at least ¶0049, wherein Benjamin discloses performance dimensions that a metrics by which a supplier could be judged (i.e. supplier characteristics)),

and one or more client-driven performance criteria definitions (¶0018, wherein Benjamin discloses the interface is further adapted to receive data associated with the proposed job; ¶0077-¶0078),

and producing a grid vendor selection which meets said client-driven performance definitions according its grid resource characteristics, and which is indicated to historically meet desired performance criteria (see at least Claim 14, wherein Benjamin discloses receiving data with a proposed job (i.e. client driven performance definitions) and generating a second performance vector in response to the received data, generating a second job attribute vector in response to the received data, and selecting the first or second supplier based on the first supplier rating matrix, the second supplier rating matrix (i.e. indicated to historically meet desired performance), the second performance vector and second job attribute vector (i.e. which meets said client-driven performance definitions according its grid resource characteristics)).

Benjamin does not explicitly disclose receiving one or more grid resource self-reports, each self-report having statistics regarding job processing.

Main discloses statistics regarding job processing (i.e. self-reports) (see at least column 4, lines 15-21, wherein Main discloses job performance data specified actual performance of a jobs current and previous executions).

It would have been obvious to one of ordinary skill in the art to include in the client driven performance supplied criteria supplied by the buyer, and in the analysis of job results against said client driven performance criteria, of Benjamin, the statistics regarding job processing as disclosed by Main since the claimed invention is merely a combination of old elements, and one of ordinary skill in the art would have recognized that it would produce a

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predictable result of having additional actual job result data in addition to the client driven performance criteria from which to analyze the jobs results to rank a supplier.

Benjamin does not explicitly disclose accessing at least a Service Level Agreement.

Main discloses a Service Level Agreement (see at least column 1, lines 36-40).

It would have been obvious to one of ordinary skill in the art to include in the art at the time of the invention to include in the accessing of client-driven performance criteria of Benjamin the accessing of a Service Level Agreement as disclosed in Main since the claimed invention is merely a combination of old elements, and one of ordinary skill in the art would have recognized that it would produce a predictable result of having the Service Level Agreement define the job data associated with the proposed job.

Benjamin does not explicitly disclose where job type is selected from a group of Online Transaction Processing jobs, batch jobs, database jobs, and scientific jobs

Main discloses monitoring performance of selected data processing jobs (i.e. selected from a group of batch jobs) (see at least column 8, lines 48-54, wherein the client workstation retrieves records for the jobs selected; and see at least Abstract and column 1, lines 65-68 wherein Main discloses the system is directed to monitoring performance of selected data processing jobs (i.e. selected from a group of batch jobs)).

It would have been obvious to one of ordinary skill in the art to include in the job types of Benjamin the selected data processing jobs of Main since the claimed invention is merely a combination of old elements, and one of ordinary skill in the art would have recognized that it would produce a predictable result of using industry specific jobs to rank the service provider.

Neither Benjamin nor Main explicitly discloses producing a rank-ordered Grid Vendor Rating Table.

Shoquist discloses producing a list of suppliers ranked according to certain criteria (i.e. a rank-ordered Grid Vendor Rating Table) (see at least column 6, lines 50-59, FIG.10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the ratings of suppliers of the combined invention of Benjamin and Main the producing the ranked list of suppliers as disclosed by Shoquist since the claimed invention is merely a combination of old elements, and one of ordinary skill in the art would have recognized that it would produce a predictable result of displaying the ratings of each supplier in a single table, and would further produce the predictable result of accessing the data from the table, to indicate which supplier met the desired performance criteria, since the data used is the same, just displayed in a table.

Conclusion

9. The prior art made of record and not relied upon considered pertinent to Applicant's disclosure.

- a. Aycock et al. (U.S. Patent 5,765,138) discloses interactive evaluation of potential vendors.
- b. Lidow (U.S. Patent Pub. 2002/0019761) discloses supply chain architecture and forecasts compared to contractual agreements.
- c. Spencer (U.S. Patent 6,356,909) discloses automated responses to and evaluations of request for proposals.

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- d. Elnozahy et al. (U.S. Patent Pub. 2002/0077836) discloses verification of service level agreements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN MILLER whose telephone number is (571)270-5288.

The examiner can normally be reached on Mon - Thur, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BETH BOSWELL can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALAN MILLER/
Examiner, Art Unit 3623

/Bradley Bayat/
Supervisory Patent Examiner, Art Unit 3623